

REMARKS

Reconsideration of this application is respectfully requested. Claims 1-16 are pending. Because claim 16 has been withdrawn from consideration, only claims 1-15 are at issue.

Obviousness Rejection over U.S. Patent No. 5,760,088

Claims 1-16 have been rejected under U.S.C. §103(a) as obvious over U.S. Patent No. 5,760,088 to Walker ("the '088 Patent"). The '088 Patent discloses preparing a quaternary ammonium hydroxide by reacting a quaternary ammonium halide with a metal hydroxide. The Examiner contends that the '088 Patent discloses that the reaction can take place in a "single solvent system, mixture of solvent systems, alcohol solvent system, alcohol/water solvent system or ammonia/water solvent system" (Office Action, page 4). The Examiner further contends that although the '088 Patent does not specifically teach the use of an aminoalcohol solvent, the use of any solvent system is suggested by the '088 Patent, and therefore the use of an aminoalcohol solvent, as required by claim 1, would have been obvious to one of ordinary skill in the art.

Applicants respectfully traverse this rejection and request reconsideration.

Claims 1-16 recite reacting a particular quaternary ammonium halide with a metal hydroxide in an aminoalcohol solvent to yield a quaternary ammonium hydroxide compound.

The '088 Patent does not disclose an aminoalcohol solvent. All of the claim limitations must be found in the prior art to establish *prima facie* obviousness. See M.P.E.P. §2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Because the '088 Patent does not disclose any aminoalcohol solvents, a *prima facie* case of obviousness has not been established.

The Examiner cites the following paragraph of the '088 Patent as suggesting that any solvent system can be used for the reaction producing the quaternary ammonium hydroxide:

Di C₈-C₁₂ alkyl quaternary ammonium hydroxides, and particularly those prepared by the method of the present invention, can be formulated as metal-free wood preservation systems. These systems include biocidal effective amounts of at least one hydroxy quat and a suitable solvent, including aqueous and non-aqueous solvents. Preferably, the solvent is an aqueous solvent including, but not limited to, water, aqueous alcohol such as ethanol, ammonia water, and the like, or a combination of any of the foregoing.

(column 6, lines 8-16, of the '088 Patent).

This paragraph is directed towards the formulation of a wood preservation system comprising specific quaternary ammonium hydroxides, at least one hydroxy quat and a suitable solvent. It is this solvent, for the wood preservation system, that the '088 Patent suggests can be "aqueous and non-aqueous ... including, but not limited to, water, aqueous alcohol such as ethanol, ammonia water, and the like, or a combination of any of the foregoing" (the '088 Patent, column 6, lines 14-16). The '088 Patent never suggests that this solvent could be used for the production of the quaternary ammonium hydroxide. In fact, the '088 Patent is very specific in which solvents are used for the production of the quaternary ammonium hydroxide:

The reaction is conducted in a solvent which comprises a C₁-C₄ normal alcohol.

Preferably, the solvent is ethanol, and most preferably, anhydrous ethanol.

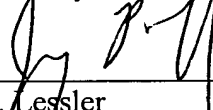
(column 5, lines 22-24, of the '088 Patent). Accordingly, one of ordinary skill in the art would not have had any motivation for modifying the solvent of the '088 Patent from a C₁-C₄ normal alcohol to an aminoalcohol.

For the foregoing reason, the '088 Patent fails to render claims 1-16 obvious. Accordingly, applicants respectfully request withdrawal of this rejection.

In view of the above remarks, applicants believe the pending application is in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: December 1, 2005

Respectfully submitted,

By 
Jay P. Lessler

Registration No.: 41,151
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(206) 262-8919
(212) 527-7701 (Fax)
Attorneys/Agents For Applicant